



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,080	03/13/2001	Satoshi Arakawa	Q61195	9113

7590 10/15/2003  
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER

LEE, SHUN K

ART UNIT PAPER NUMBER

2878

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/804,080	ARAKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shun Lee	2878	

--Th MAILING DATE of this communication appears on th cover sh et with th correspondenc addr ss--

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).
- Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 2, 4 and 11.

Claim(s) withdrawn from consideration: 3, 5-10, 12 and 13.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
**CONSTANTINE HANNAHER**  
**PRIMARY EXAMINER**  
**GROUP ART UNIT 2878**

Continuation of 5. does NOT place the application in condition for allowance because: applicant argues that the stimutable phosphor layer is not overlaid on the front surface side of a transparent substrate, but on a back side of the transparent substrate 1A of Hosoi et al. and cites Fig. 5 and column 5, lines 15-17 of Hosoi et al. as support. Examiner respectfully disagrees. It is noted that column 5, lines 15-17 of Hosoi et al. states "The stimulating ray source 2 linearly emits stimulating rays onto the stimutable phosphor sheet 1 via the slit member 2A". Thus it is unclear what characteristic of the plurality of surface sides of transparent substrate 1A lead to one side being labeled the back side by applicant. First it should be recognized that a transparent substrate has a plurality of surface sides. Claim 1 recites the limitation of a "transparent substrate and stimutable phosphor layer overlaid on a front surface side of the transparent substrate". Thus, the claim clearly recites that the surface side of the transparent substrate upon which a stimutable phosphor layer is overlaid is the "front" surface side. Therefore, using the "front" surface side as described in the claims, the stimutable phosphor layer 1B is overlaid on the "front" surface side of the transparent substrate 1A of Hosoi et al. Further, in response to applicant's argument that a cassette and an image storage panel used must be compatible in order to function appropriately and that modifying the cassette of Sakuma to incorporate the stimutable phosphor layer and transparent substrate of Hosoi et al., would require a substantial reconstruction and redesign of Sakuma as well as a change in the basic principle under which the construction was designed to operate, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In addition, applicant fails to specify the incompatibilities between the cassette of Sakuma and an image storage panel (and the reconstruction, redesign, and the basic operating principle changes). Moreover as discussed in the previous office action, Verbeke et al. state (column 2, lines 1-13) that "The cassettes used in PSL radiography must have external dimensions which, are compatible with those of conventional X-ray photography cassettes so that the PSL cassettes can be exposed in the cassette holder of a conventional X-ray machine. This is not, of course, to imply that all radiography cassettes are of the same format: they are not, they vary in format from about A5 paper size suitable for wrist X-rays to about A2 for chest X-rays and even larger. In fact, the practice has developed of depositing the phosphor layer on a conventional X-ray film base and of exposing it in a conventional X-ray photography cassette which is modified only in that it does not contain any X-ray sensitive luminescent layer". Thus it is clear that image storage panels are typically used with "conventional" cassettes. Therefore, applicant's arguments are not persuasive.